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7590 05/17/2004
Joe Zheng
7394 Wildflower Way
Cupertino, CA 95014

EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/17/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,922

Applicant(s)

SUN ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 14 recites the limitation "the mobile device" in line 15, on page 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10 and 14-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent Application Publication No. US 2002/0118798 by Langhart et al, hereinafter Langhart.

Regarding claim 1, Langhart discloses a mobile apparatus comprising: a mobile device with telephonic capabilities so that a user of the mobile apparatus can make a call and receive a call while in motion (page 2, column 1, section 0019, lines 1-7), the mobile device including a user interface (page 2, column 2, section 0020, lines 16-19); a recording mechanism integrated within the mobile device (page 2, column 2, section 0019, lines 9-13) and controllable through the user interface (page 2, column 2, section 0020, lines 1-19); and wherein the recording

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mechanism records an audio input when the user is engaged in a phone conversation with a caller so that the audio input can be replayed later (page 2, column 2, section 0021, lines 1-27), and wherein depending on a local regulation, the audio input includes one of a voice from the user only, a voice from the caller only, and the phone conversation between the user and the caller (page 2, column 2, section 0020, lines 10-16; page 2, column 2, section 0021, lines 1-11).

Regarding claim 2, the mobile apparatus of claim 1 mentioned above, wherein Langhart further discloses the mobile device includes a processor (Figure 2, 155) and a digital memory space or conversation storage unit (Figure 2, 150); and wherein the recording mechanism operates under the processor and digitizes the audio input into an audio file that is stored in the digital memory space (page 2, column 2, section 0021, lines 1-27).

Regarding claim 3, the mobile apparatus of claim 2 mentioned above, wherein Langhart further discloses the digital memory space is either non-removable memory or removable memory (page 3, column 1, section 0022, lines 1-6).

Regarding claim 4, the mobile apparatus of claim 2 mentioned above, wherein Langhart further discloses the digital memory space is inherently Audio grade dynamic RAM (page 3, column 1, section 0022, lines 1-6).

Regarding claim 5, the mobile apparatus of claim 1 mentioned above, wherein Langhart further discloses the recording mechanism operates upon an activation of a key in the user interface (page 2, column 2, section 0020, lines 16-19).

Regarding claim 6, the mobile apparatus of claim 1 mentioned above, wherein Langhart further discloses the mobile device includes a digital memory space or conversation storage unit (Figure 2, 150), a microphone, and a speaker, wherein the mobile device inherently has a

microphone and a speaker in order for the recording mechanism to record and emit audio from the mobile device (page 2, column 1, section 0018, lines 5-16); and wherein the recording mechanism is used as an audio recorder to record the audio input inherently received from the microphone, to store the recorded audio input in the digital memory space (page 2, column 2, section 0021, lines 1-10).

Regarding claim 7, the mobile apparatus of claim 6 mentioned above, wherein Langhart further discloses the recorded audio input is inherently replayed and listened to through the speaker (page 2, column 2, section 0021, lines 11-27).

Regarding claim 8, the mobile apparatus of claim 1 mentioned above, wherein Langhart further discloses the user interface inherently includes a set of keys and a display (Figure 1, 105), the display displaying options for the user to place the mobile apparatus in a desired operation mode (page 2, column 2, section 0020, lines 16-19).

Regarding claim 9, the mobile apparatus of claim 8 mentioned above, wherein Langhart further discloses the desired operation mode includes recording mode or 'start-memo-recording' mode, calling mode, and recording/calling mode or 'start-recording' mode; and wherein: the mobile apparatus functions as a telephone when the calling mode is inherently selected, this is the default mode when a call comes into a mobile device and no recording mechanism has been selected (page 2, column 1, section 0019, lines 1-14); the mobile apparatus functions as an audio recorder when the recording mode or 'start-memo-recording' modes is selected (page 2, column 2, section 0020, lines 10-19; page 3, column 1, section 0025, lines 1-11); and the mobile apparatus functions as a conversation recorder when the recording/calling mode or 'start-recording' mode is selected (page 2, column 2, section 0021, lines 1-8).

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Regarding claim 10, the mobile apparatus of claim 1 mentioned above, wherein Langhart further discloses the mobile device is capable of data communication with another computing device; and wherein the audio input is processed in the mobile device and the processed audio input can be transferred to the another computing device (page 3, column 2, section 0028, lines 1-24; page 5, column 2, section 0042, lines 1-14).

Regarding claim 14, Langhart discloses a method for using a mobile apparatus, the method comprising: providing the mobile apparatus, wherein a mobile device (Figure 1, 105) includes: a wireless telephone inherently having a microphone and a speaker, wherein the mobile device inherently has a microphone and a speaker in order for the recording mechanism to record and emit audio from the mobile telephone (page 2, column 1, section 0018, lines 5-16); and an audio recording mechanism integrated within the wireless telephone (page 2, column 2, section 0020, lines 1-10); using the audio recording mechanism to record an audio input (page 2, column 2, section 0020, lines 10-12), wherein the audio recording mechanism is automatically suspended when the wireless telephone is engaged in a phone conversation with a caller (page 4, column 2, section 0037, lines 1-9), depending on user preferences; and playing back the recorded audio input from the audio recording mechanism inherently through a speaker of the wireless telephone (page 2, column 2, section 0021, lines 11-23).

Regarding claim 15, the method of claim 14 mentioned above, wherein Langhart further discloses forwarding the recorded audio input to a different device; and playing back the recorded audio input from the different device (page 3, column 2, section 0028, lines 1-24; page 5, column 2, section 0042, lines 1-14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. US 2002/0118798 by Langhart.

Regarding claim 11, Langhart discloses a mobile apparatus comprising: a wireless telephone inherently including a processor (Figure 2, 155), a digital memory space or conversation storage unit (Figure 2, 150), a microphone and a speaker, wherein the mobile telephone inherently has a microphone and a speaker in order for the recording mechanism to record and emit audio from the mobile telephone (page 2, column 1, section 0018, lines 5-16); and an audio recording mechanism integrated within the wireless telephone and operating under the processor (page 2, column 2, section 0020, lines 1-10), the audio recording mechanism recording an audio input received from the microphone when the wireless telephone is telephonic operations (page 2, column 1, section 0018, lines 16-22), wherein the audio recording mechanism is automatically suspended when the wireless telephone is engaged in a phone conversation with a caller, depending on user preferences (page 4, column 2, section 0037, lines 1-9).

Langhart does not disclose the audio recording mechanism recording an audio input received from the microphone when the wireless telephone is not in telephonic operations.

Langhart discloses a commercially available solution for automating a note-taking

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task that includes a SCH-8500 mobile telephone from Samsung Electronics Company. The SCH-8500 includes a "memo recording feature" that, if there is no call in progress, records the speech only of the party who initiated the memo recording feature. If a call is in progress and the mobile telephone is in digital mode, the speech of only the called party is recorded and this speech can be recorded for a maximum of one minute (page 1, column 1, section 0004, lines 1-16)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile apparatus of Langhart to include the audio recording mechanism recording an audio input received from the microphone when the wireless telephone is not inherently in telephonic operations as mentioned in Langhart. One of ordinary skill in the art would have been lead to make such a modification since Langhart mentions that the SCH-8500 includes a note-taking task function when the telephone is not in telephonic operations that can be distinguished as another option in the claimed invention, wherein the user wants to record audio that is not included in an ongoing conversation.

Regarding claim 12, the mobile apparatus of claim 11 mentioned above, wherein Langhart further discloses the mobile device the audio input is digitized and the digitized audio input is stored in the digital memory space (page 2, column 2, section 0021, lines 1-27).

Regarding claim 13, the mobile apparatus of claim 12 mentioned above, wherein Langhart further discloses the digitized audio input stored in the digital memory space can be replayed and listened to (page 2, column 2, section 0021, lines 11-23).

Response to Amendment

7. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

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Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

May 7, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

